

AMENDMENT IN RESPONSE TO *EX PARTE QUAYLE* ACTION
U.S. Application No. 09/918,497

Q65530

REMARKS

Claims 6 and 14 are all the claims pending in the application.

In the Ex Parte Quayle Action of December 12, 2006, the Examiner suggests a number of claim amendments which are dealt with below individually.

Statement of Substance of the Interview

A telephonic interview was conducted by Applicant's representative with the Examiner on January 9, 2006. In the interview, the current objections to claims 6 and 14 (explained below) were discussed.

Changing "decoding means" to "a decoder" and "RAKE combining means" to "a RAKE combiner"

In the first and second paragraphs of his explanation (page 2), the Examiner indicates that all instances of "decoding means" and "RAKE combining means" in claims 6 and 14 should be changed to "a decoder" and "a RAKE combiner," respectively.

With this Amendment, Applicant amends claims 6 and 14, as shown, in accordance with the Examiner's suggestions.

Inserting "each of" after "from" in claim 6

In the first paragraph of his explanation (page 2), the Examiner indicates that the phrase "a respective one of" or the phrase "each of" should be inserted as follows in claim 6: "decoding means for decoding a received signal outputted from each of said plurality of reception processing blocks".

As this limitation currently stands, it recites a decoding means for receiving a signal from a plurality of reception processing blocks. In other words, there is no limitation in the claim that the received signal be received from any particular processing block or that a separate signal must be

AMENDMENT IN RESPONSE TO EX PARTE QUAYLE ACTION
U.S. Application No. 09/918,497

Q65530

received from each of a number of processing blocks. If the claim is amended as suggested by the Examiner, it will add a limitation that a signal must be received from each of the plurality of reception blocks.

Regarding this suggested amendment, the Examiner has explained that the specification of the present invention discusses that each of a plurality of processing blocks outputs a signal and therefore, a claim with recites receiving a signal from the plurality of processing blocks, as recited in claim 6, must be changed to comport with the specification. The Examiner appears to be asserting that there is an issue under § 112, first paragraph, in other words, that this limitation is not supported in the specification. However, the Examiner is incorrect.

First, if the Examiner intended to make a rejection of claim 6 under 35 U.S.C. § 112, first paragraph, he must do so in a non-final Office Action. Such a rejection is not appropriate in an action under *Ex Parte Quayle* practice.

Further, as noted above, no limitation of claim 6 prohibits each processing block from outputting a signal, as discussed in the specification. The instant limitation of claim 6 merely recites that the decoding means is for receiving *a* signal. It *does not* require that the decoding means receive *only* one signal. Therefore, the Examiner's amendment is misplaced.

Therefore, regarding this proposed amendment, Applicant respectfully declines to amend the claims at this time and requests that if the Examiner intends to make a rejection of claim 6 under 35 U.S.C. § 112, first paragraph, that he do so in a new, non-final Office Action and provide an explanation as to why such a limitation is necessary.

AMENDMENT IN RESPONSE TO *EX PARTE* QUAYLE ACTION
U.S. Application No. 09/918,497

Q65530

Adding “each of said memories configured to store an output of a corresponding one of said plurality of reception processing blocks”

Also in the first paragraph of his explanation (page 2), the Examiner indicates that the phrase “each of said memories configured to store an output of a corresponding one of said plurality of reception processing blocks” should be inserted as follows in claim 6: “a plurality of memories, each of which is connected between said decoding means and RAKE combining means in each of said reception processing blocks, each of said memories configured to store an output of a corresponding one of said plurality of reception processing blocks”.

This suggested amendment is a substantive amendment which would narrow the scope of the claim. The Examiner indicates that this amendment is necessary to clarify that there is a separate memory which stores an output of each of the processing blocks. However, again, the Examiner appears to be asserting that there is an issue under §112, first paragraph, in other words, that this limitation is not supported in the specification because in the specification there is a memory for each processing block. However, the Examiner is incorrect. As shown, for example, in Figure 1, there is no separate memory associated with the voice/low-speed data reception block. Furthermore, there is no requirement that a claim recite each and every exemplary limitation described in the specification. The Examiner has failed to indicate why such a limitation is necessary to the present invention.

Therefore, regarding this proposed amendment, Applicant again respectfully declines to amend the claims at this time and requests that if the Examiner intends to make a rejection of claim 6 under 35 U.S.C. § 112, first paragraph, that he do so in a new, non-final Office Action and provide an explanation as to why such a limitation is necessary.

AMENDMENT IN RESPONSE TO *EX PARTE* QUAYLE ACTION
U.S. Application No. 09/918,497

Q65530

Clarifying “said received signal having a high priority”

In the first and second paragraphs of his explanation (pages 2-3), the Examiner refers to the phrase “said received signal having a high priority”, in each of claims 6 and 14, requires clarification.

With this Amendment, therefore, Applicant amends claims 6 and 14 as shown, to clarify the phrase “said received signal having a high priority”.

Changing “one of reception processing blocks” to “a plurality of reception processing blocks”

In the second paragraph of his explanation (pages 2-3), the Examiner indicates that “one of” should be changed to “a plurality of” as follows in claim 14: “allocating said received CDMA signal to ~~one~~ a plurality of reception processing blocks, depending on the service type”.

As this limitation currently stands, it recites that a received CDMA signal is allocated to one reception processing block [of a number of reception processing blocks] depending on the service type of the received CDMA signal. There is no description or suggestion in the specification of the present invention that a CDMA signal is allocated to *a plurality* of processing blocks according to service type, as suggested by the Examiner.

With this Amendment, for purposes of clarity, Applicant amends claim 14, as shown, to recite: allocating said received CDMA signal to one of a plurality of reception processing blocks, depending on the service type”.

Regarding whether the received signal is stored in one of the memories

Also in the second paragraph of his explanation (pages 2-3), the Examiner asks whether, in line 7 of claim 14, the received signal is stored in “one of the memories,” and suggests that an amendment be made to clarify this point.

AMENDMENT IN RESPONSE TO *EX PARTE* QUAYLE ACTION
U.S. Application No. 09/918,497

Q65530

Regarding this question, with this Amendment, Applicant amends claim 14, as shown, to clarify the recited memories.

Regarding where the signal stored in memory is received from

Also in the second paragraph of his explanation (pages 2-3), the Examiner asks where the received signal which is stored in memory is received from.

Applicant notes again that there is no requirement that each and every possible limitation described in the specification be incorporated into the claims. The Examiner has provided no explanation as to why a limitation reciting where the signal is received from is *necessary* to the present invention.

Applicant again respectfully declines to amend the claims at this time and requests that if the Examiner intends to make a rejection of claim 6 under 35 U.S.C. § 112, first paragraph, that he do so in a new, non-final Office Action and provide an explanation as to why such a limitation is necessary.

Adding “using said decoder”

Also in the second paragraph of his explanation (pages 2-3), the Examiner indicates that the phrase “using said decoder” should be inserted as follows in claim 14: “reading out said received signal [...] successsively from said memories using said decoder”.

We note again that there is no requirement that each and every possible limitation described in the specification be incorporated into the claims. The Examiner has provided no explanation as to why a limitation reciting how a signal is read out is *necessary* to the present invention.

Applicant again respectfully declines to amend the claims at this time and requests that if the Examiner intends to make a rejection of claim 6 under 35 U.S.C. § 112, first paragraph, that he do so

AMENDMENT IN RESPONSE TO *EX PARTE* QUAYLE ACTION
U.S. Application No. 09/918,497

Q65530

in a new, non-final Office Action and provide an explanation as to why such a limitation is necessary.

Changing “outputted from said plurality of said reception processing blocks” to “read out from the memories using said decoder”

Also in the second paragraph of his explanation (pages 2-3), the Examiner indicates that claim 14 should be amended as follows: “decoding said received signal ~~outputted from said plurality of said reception processing blocks~~ read out from the memories using said decoder”.

With this Amendment, Applicant amends claim 14, as shown, for purposes of clarity.

Conclusion

In view of the above, Applicant respectfully requests that the objections to the claims be reconsidered and withdrawn.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

AMENDMENT IN RESPONSE TO EX PARTE QUAYLE ACTION
U.S. Application No. 09/918,497

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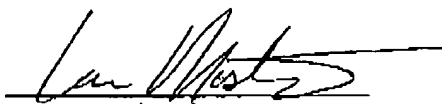
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Date: February 13, 2006

CERTIFICATION OF FACSIMILE TRANSMISSION

Sir:

I hereby certify that the above identified correspondence is being facsimile transmitted to Examiner **Jean CORRIELUS** at the Patent and Trademark Office on **February 13, 2006** at **571-273-8300**.

Respectfully submitted,


Laura Moskowitz